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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,978	03/15/2001	Yoshinori Ohta	5-027US-FF	3790

7590 12/24/2003

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EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/805,978

Applicant(s)

OHTA, YOSHINORI

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Status of Claims***

1. Claims 1-18 have been examined.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-5, 7, and 11-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Freedman, U.S. Patent No. 4,839,829.

As per claims 1, 3-5, 7, and 11-13 Freedman teaches an image ordering system comprising:

- a server, first client computer and a second computer connected via a communication network (figures 1A-B)
- a first client computer comprising: an input unit for specifying an image and a transmitting unit for transmitting to a server said image specifying data (abstract; figures 1A-B)

- server comprising: receiving unit for receiving image specifying data, transmitting unit for image and orderer specifying data to a second client computer (abstract; figures 1A-B; column/line 7/62-8/35)
- a server with an image database for storing thumbnail images (column/line 8/55-9/63)
- a server with calculation unit that calculates an estimated fee for printing an image based on image specifying data, transmitting the fee (e.g. of orderers affiliated with a second client computer) to a client computer (column/line 9/63-10/35)
- a first client computer that receives a fee estimate from the server and an alerting unit for giving notice of the estimate (column/line 9/63-10/35)
- second client computer comprising: receiving unit for receiving image specifying and orderer data, printer controller, and an alerting unit (abstract; figures 2B; column 8, lines 1-20; column 10, lines 27-35)
- a first setting unit for setting at least one of a lab affiliated with an agency and an orderer affiliated with a lab and for transmitting this data to a server (column/line 7/62-8/14; column 10, lines 15-35)

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 in view of Hartman et al., U.S. Patent No. 5,960,411.

As per claim 2, Freedman teaches a network ordering system comprising: a plurality of client computers in communication with a server with memory (abstract; figure 1), a client computer specifying order data such as a print facility for fulfilling an order and transmitting a clients order over a network to the specified facility (column 10, lines 25-35). However, Freedman does not specifically storing order data for use in subsequent orders. Hartman et al. teach a network ordering system comprising a server with memory for retaining client order preferences for use in subsequent orders and a determining unit fulfilling orders based on the preference data (abstract). Therefore it would have been obvious to one of ordinary skill to combine the teachings of Freedman and Hartman et al. in order to make the ordering process more efficient.

6. Claims 6 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829.

As per claims 6 and 14-18, Freedman teaches an image ordering system that comprises a server transmitting order parameters to a first and second client computers (column 10, lines 15-35). Freedman also teaches a second client computer giving notice of information received regarding received data such as acceptance of a print job and responses to inquiries regarding job status (column 10, lines 31-54). Freedman doesn't specifically recite transmitting fee data or orderer specifying data to a second client computer. However, Freedman recites the server transmitting image specifying data and all other parameters and other information to second client computer (column 10, lines 27-35), hence, it would have been obvious to one of ordinary skill for the server to send first client identity data and/or a replica of the receipt (e.g. specifying data, prices) sent to the first client computer (column 10, lines 33-35) to facilitate the matching and resolution, in the case of discrepancies, of orders.

7. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 in view of Greulich et al., U.S. Patent No. 6,018,338.

As per claims 8-10, Freedman teaches a network ordering method and system that connects over a communication link a server, a first client computer

and a second client computer and transmits image specifying data and all other parameters and other information between the parties (abstract; figures 1A-2B; column 10, lines 27-35). Freedman also teaches a first client computer providing a server with payment data (column 8, lines 1-10) and a second client computer accepting the order (column 10, lines 30-35). The latter, suggests, to one of ordinary skill, a verification unit and that a second client computer may choose not to accept the order if the order data and all other parameters and other information was found unacceptable. However, Freedman doesn't specifically recite transmitting fee data to a third client computer. Greulich et al. teach a network ordering system and method that comprises a third party for verifying a first client ability to pay for a service provided by the second client computer (figure 1; column 5, lines 45-51). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman and Greulich et al. in order to prevent fraud.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- Farros et al. teach a network image printing system
  - Garfinkle et al. teach a system for processing film over a network

- Stefik et al. teach a system controlling the printing of intellectual property
- Moghadam et al. teach a system for processing film over a network
- Zingher teaches a print job allocation system

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

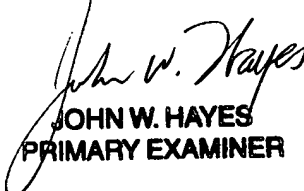


Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application  
should be directed to the Group receptionist whose telephone number is (703)  
308-1113.

Calvin Loyd Hewitt II

December 14, 2003

  
**JOHN W. HAYES**  
**PRIMARY EXAMINER**